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Wilfried Blum

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,311	Applicant(s) BLUM ET AL.	
	Examiner PAUL R. FISHER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7, 9-20, 28-29, 31-34, and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment submitted on February 20, 2009 has been acknowledged. Claims 3, 8, 21-27, 30 and 35 have been cancelled. Claims 38-41 have been added. Claims 1-2, 4-7, 9-20, 28-29, 31-34, and 36-41 are currently pending and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 20, 2009 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly recited limitation of "said assessment comprising a grade for the vehicular part" found in claims

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1, 28 and 41 has no support in the applicant's specification. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. Since they are equivalent there is no support for the assessment to comprise a grade, and that the grade and not the assessment is used to determine the disposition of the part.

5. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. Since they are equivalent there is no support for the assessment to comprise a grade, and that the grade and not the assessment is used to determine the disposition of the part. One of ordinary skill in the art would not be able to perform the claimed invention based on the specification since there is no clear guidance as to how the assessment can comprise a grade when the grade is equivalent to the assessment.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-2, 4-7, 9-20, 28-29, 31-34, 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claim 1, the recited term "said assessment comprising a grade for the vehicular part", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

9. Claim 6 recites the limitation "wherein said disposing of" in line 2, of claim 6. There is insufficient antecedent basis for this limitation in the claim. There is no step of disposing in claim 1 only determining a disposition.

10. Claims 2, 4-7, 9-20, and 38-40 depend from claim 1 and are therefore rejected upon the same rationale.

11. In claim 28, the recited term "include said grade of said assessment", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

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12. Claim 28 recites the limitation "determine the disposition" in 17, of claim 28.

There is insufficient antecedent basis for this limitation in the claim. It is unclear how there can be the disposition when a disposition has not yet occurred.

13. In claim 33, the recited term "a disposition", renders the claim indefinite. It is unclear if this is referring to a new disposition or the disposition mentioned in claim 28.

14. Claims 28-29, 31-34, and 36-37 depend from claim 28 and are therefore rejected upon the same rationale.

15. Claim 39 recites the limitation "in the disposing step" in line 2, of claim 39. There is insufficient antecedent basis for this limitation in the claim. There is no step of disposing in claim 1 only determining a disposition.

16. In claim 41, the recited term "the assessment comprising a grade for the vehicular part", renders the claim indefinite. Based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." the grade and the assessment are equivalent. It is therefore confusing what is meant by grade and how the assessment can comprise a grade when the grade and the assessment are considered to be equivalent.

Claim Rejections - 35 USC § 101

17. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

18. Claims 1-2, 4-7, 9-20, and 38-41 are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiner is that a § 101 process must (1) be tied to another statutory class

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(such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is substantially tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here the steps can be performed by a human and the sending and receiving is a nominal recitation of a computer.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 28, 29, 31, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao (US2002/0016655A1).

As per claim 28, Joao discloses a data center used in a remote evaluation of a vehicular part (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said data center comprising:

a computer server adapted to communicate with a vehicular dealer and an assessment center (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the first location and the second location that could be any of the computers connected to the network), said computer server comprising:

input means for receiving, from said vehicular dealer, said electronic folder including said description information regarding said condition of said vehicular part in an electronic folder (Page 21, paragraph 283; discloses that the user enters information that is to be sent to the central server via a computer. Page 12, paragraph 173; discloses various input devices to enter information into the system);

output means for sending said description information to said assessment center (Page 15, paragraph 213; discloses output devices the could be used by the system);
and

said input means for receiving, from said assessment center, an assessment based on said description information, said assessment comprising a grade for the vehicular part, said electronic folder having been modified at said assessment center to

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include said grade of said assessment (Page 22, paragraph 293; discloses the user being sent the report or assessment. Page 12, paragraph 173; discloses various input devices to enter information into the system).

said output means for sending said electronic folder including said grade to the vehicular dealer where the grade will be used to determine the disposition of the vehicular part (Page 15, paragraph 213; discloses output devices the could be used by the system).

The information being transfer or sent and received is considered to be non-functional descriptive material since it adds not further limitations to the structure of the system and is therefore given little or no patentable weight.

As per claim 29, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 31, Joao discloses the above-enclosed invention, Joao further discloses comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 32, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location

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(Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

As per claim 36, Joao discloses the above-enclosed invention, Joao further comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claims 1, 2, 4-7, 9-20, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: “Parts Remanufacturing in the Automotive Industry” (First Quarter 1997) hereafter Hormozi.**

As per claim 1, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers) comprising:

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obtaining, from a vehicular dealer, description information regarding said vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending, from a central server, said electronic folder including said description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving from said assessment center, the electronic folder updated with an assessment based on said description information, said electronic folder being modified at said assessment center to include said assessment, said assessment comprising a grade (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") for the vehicle part (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or

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part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well); and

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches determining whether said vehicular part may be recycled based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

As per claim 2, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said

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vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 4, Joao discloses the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 5, Joao discloses the above-enclosed invention, Joao further discloses wherein said data and reports are compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 6, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein said disposing of said vehicular part comprises at least one of discarding the vehicular part and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 7, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 9, Joao discloses the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 10, Joao discloses the above-enclosed invention, Joao further discloses wherein said data and reports are in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 11, Joao discloses the above-enclosed invention, Joao further discloses that the system is used to facilitate the process of repairing parts or performing services associated with those parts (Page 22, paragraph 290; discloses the central server takes in information that will help in the repair process for parts and services). Joao also discloses that many facilities can access the system (Page 22, paragraph 299; discloses that multiple parties can access the system in regard to repair and servicing of parts, these parties include intermediary or third party sites).

Joao fails to explicitly disclose sending said vehicular part to a third party for at least one of repair and recycling.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches sending vehicular parts to a third party and that services provided by the third party include repair and recycling (Page 26, paragraphs 2 and 6; teach that there are five services that can be performed two of which are repair and recycling, and that 90% of sales come from independent channels such as third parties. Page 26, paragraph 8; teaches that companies like Ford motor company have often relied on third party sites

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to repair and remanufacture items since they did not have the resources, from this it would be obvious that in the case of repair and recycling of parts third parties would be used if the facilities such as the dealer does not have the resources on site to complete the task. Also it would have been obvious that since these third party sites are not located on site they would have to have the parts sent to them).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of sending third parties parts for repair or recycling taught by Hormozi, to accomplish the required services for the customer. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled. Since the system is dealing with third parties or companies that are not onsite the parts that have to be services would have to be sent to them in order for them to be repaired or recycled.

As per claim 12, The combination Joao and Hormozi teaches the above-enclosed invention, Joao further discloses providing an assessment detail based on vehicular parts (Page 22, paragraph 289; discloses that the different services providers can provide a diagnosis or an assessment regarding the state of disrepair of the part).

Joao fails to explicitly disclose comprising at least one of identifying and ordering missing materials required for a remanufacturing of said vehicular part based on said assessment details.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising at least one of identifying and ordering missing materials required for remanufacturing of said vehicular part based on said assessment details (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced).

As per claim 13, the combination Joao and Hormozi teaches the above-enclosed invention; Joao fails to fully disclose comprising the automatically ordering said materials required for remanufacturing of said vehicular part.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising the automated ordering of said materials required for remanufacturing of said vehicular part (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced and that these pieces are ordered automatically if it is guaranteed that those parts will be replaced, as stated with a RF rating of 1.00, which states that every time the person in going to remanufacture that part, that piece is going to have to be replaced every time).

As per claim 14, Joao discloses the above-enclosed invention, Joao further discloses that original equipment manufacturers have intermediaries or third parties

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handle things (Page 2, paragraph 21; discloses that intermediaries can act on behalf of the vehicle manufacturers which are the OEM or original equipment manufacturers.

Page 22, paragraph 299; discloses that these intermediaries can access the system at any time. Page 21, paragraph 281; discloses that the first location can be the vehicle manufacturer and/or intermediaries).

Joao fails to explicitly disclose where the representative or intermediary is authorized.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches that representatives of the original equipment manufacturer are authorized (Page 26, paragraph 8; teaches that Ford used outside companies as intermediaries for the exchanged of parts and services and those intermediaries were authorized representatives).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of authorized intermediaries or third parties taught by Hormozi, for the purpose of ensuring the quality of work to their customers. If the third party did not have a high standard of work it would reflect poorly upon the original equipment manufacturer so by authorizing these companies shows the customer that these facilities are up to par with the original equipment manufacturer. Also as stated in the article this deal benefits the OEM because in some cases these they don't have the infrastructure or the resources to take on such a service so these third parties offer a reliable alternative.

As per claim 15, Joao discloses the above-enclosed invention, Joao further discloses wherein assessment center comprises at least one of an independent assessing center, an original equipment manufacturer, and a warranty processing center (Page 22, paragraph 290; discloses that the assessment can be any one of an independent assessing center or repair shop, equipment manufacturers, warranty providers as well as others).

As per claim 16, Joao discloses the above-enclosed invention, Joao further discloses comprising the step of providing access to a party at a third location to said assessment details (Page 22, paragraph 299; discloses that access is granted to multiple parties at any point and those parties include intermediaries or third parties. These parties can access the system to view the assessment and to add information).

As per claim 17, Joao discloses the above-enclosed invention, Joao further discloses wherein said party at said third location accesses said assessment details through an Internet web browser (Page 11, paragraph 168; discloses that the invention functions on the Internet and can be accessed using a web site which accessing would have to include the use of a web browser).

As per claim 18, Joao discloses the above-enclosed invention, Joao further discloses wherein said party at said third location comprises an original equipment manufacturer (Page 22, paragraph 299; discloses that at any time another party can access the system which includes the vehicle manufacture or the original equipment manufacturer).

As per claim 19, Joao discloses the above-enclosed invention, Joao further discloses comprising the step of producing data and reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 20, Joao discloses the above-enclosed invention, Joao further discloses comprising the step of providing said data and reports in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 38, Joao discloses the above-enclosed invention, Joao further discloses comprising selecting an assessment center based on the description information (Page 22, paragraph 296; discloses based on the description information the user can selected an assessment center or any of the service or parts providers).

As per claim 41, Joao discloses a method for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers), comprising:

inputting, at a vehicular dealer, description information regarding the vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is

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gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending the electronic folder including the description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving the sent electronic folder at the assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center. Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts

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that a grade is shown as well, from this it is shown that the various users receive the information that was sent);

modifying the sent electronic folder at the assessment center to include an assessment based on said description information, the assessment comprising a grade for the vehicular part (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well);

receiving the modified electronic folder at the vehicular dealer (Page 22, paragraph 293; discloses that the user can receive the diagnostic report. Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center.); and

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches disposing of the vehicular based on said assessment (Page 26, paragraphs 1

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and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy than having those parts repaired or recycled.

23. Claims 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1).

As per claim 33, Joao discloses the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein the computer server is adapted to determine at least one of a disposition and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 34, Joao discloses the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 37, Joao discloses the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location

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(Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

24. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi as applied to claim 1 above, further in view of Williams et al. (US 2002/0032573 A1) hereafter Williams.

As per claim 39, the combination of Joao and Hormozi teaches the above-enclosed invention, but fails to explicitly disclose printing a shipping label based identifying a destination identified in the disposing step.

Williams, which talks about an apparatus, systems and methods for online, multi-parcel, multi-carrier, multi-service enterprise parcel shipping management, teaches printing a shipping label identifying a destination (Page 27, paragraphs [0447]-[0449]; teaches that a shipping label can be printed by the user of the system identifying a destination as well as package information details).

Therefore, from this teaching of Williams, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the printing of shipping labels that provide destination information as taught by Williams for the purpose of expediting shipping to customers as well as to service providers. By printing the labels from the stored data the user is ensured that the information is up to date and correct, which limits the room for error.

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25. **Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi as applied to claim 1 above, further in view of Untiedt et al. (7,216,096) hereafter Untiedt.**

As per claim 40, the combination of Joao and Hormozi teaches the above-enclosed invention, but fails to explicitly disclose adding an event-driven status indicator to the electronic folder for tracking the progress of a claim concerning the vehicular part.

Untiedt, which talks about an integrated inventory management system, teaches having an event-driven status indicator for tracking the progress of a vehicular part (Col. 2, lines 23-26, Col. 6, lines 3-36; teach that upon an event happening such as a dealer agreeing or disagreeing to supply a part the information regarding that customer request is updated with the current status in this case if the part was back ordered or not).

Therefore, from this teaching of Untiedt, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Hormozi with the use of status indicators as taught by Untiedt for the purpose of keeping track of client requests and ensuring that the service is fulfilled. By including a status indicator the system is aware if the order has been fulfilled or not and this helps avoid possibly forgetting a service request or trying to fulfill a service request that has already been fulfilled.

Response to Arguments

26. Applicant's arguments filed February 20, 2009 have been fully considered but they are not persuasive.

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27. In response to the applicant's argument that, "Joao refers to a vehicle while the claims refer to a condition of a vehicular part. These terms are far from equivalent," the Examiner respectfully disagrees. A vehicle itself is comprised of various parts and when giving the condition of a vehicle the condition will be relayed in various parts that need to be fixed or replaced. Further Joao states on page 12 paragraph 179 and page 13 paragraph 180, that it stores information regarding vehicle parts and that this same database is used to help diagnose problems. From this the Examiner asserts that the vehicle contains parts and the list of parts is stored and tracked in the system, and further this information is included in the diagnosis of problems and state of disrepair so the system described in Joao reads over the claims as currently written.

28. In response to the applicant's argument that, "Joao does not disclose the modification of the electronic folder at the assessment center..." and that "the claimed invention calls for different entities (1- vehicular dealer, and 2- assessment center) to enter the description information and to input an assessment based on the description information," the Examiner respectfully disagrees. Page 22, paragraph 299 of Joao discloses that at any time any over the different computers from various entities can access the information and input information regarding the vehicle. Page 10, paragraph 154, states that there can be any number of user computers used. Page 21, paragraph 279, discloses that any of the embodiments any of the computers can be used to transmit and receive information. From this the Examiner asserts that Joao does show at least two different entities exchanging information, and therefore Joao reads over the claim as currently written.

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29. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., it is not centrally maintained) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner asserts that as currently written the claims do not require that electronic folder be directly transmitted between entities. Claim 1 recites, "sending from a central server...to an assessment center", from this it is shown that there is a central server which relays the information from one entity to another, which is shown in Joao. Joao also shows that each of the entities modifies their data, page 22, paragraph 299 discloses that each user vehicle dealer, vehicle manufacturer, vehicle service provider, vehicle parts provider, service payer, vehicle insurance provider can use their own respective computers to receive information as well as input information, from this it is shown that the various entities can all receive information as well as modify information at their own computers.

30. In response to the applicant's argument that, the office action states calling up the warranty provider and "claim 33 clearly states that it is the computer server which is adapted to determine the disposition of a warranty settlement for a vehicular part," the Examiner respectfully disagrees. Claim 33 recites, "wherein said computer server is adapted to determine **at least one** of a disposition and a warranty settlement for said vehicular part based on said assessment", from this the Examiner asserts that only one need be present for the prior art to read over the claim as currently written.

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31. Further it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Further still the Examiner respectfully disagrees with the argument that the example given in the office action can not be applied to the computer server of Joao. While the example given referenced common practice when the warranty provider is part of the system of Joao it would have been obvious for that determination to be made using the system and therefore using the computer server, since the computer server would be fully capable of relaying that information to the various users.

In response to the applicant's argument that, the prior art does not disclose "supplying description information to an electronic folder at a vehicular dealer," the Examiner respectfully disagrees. As discussed above Page 22, paragraph 299 of Joao discloses that at any time any over the different computers from various entities can access the information and input information regarding the vehicle. Page 10, paragraph 154, states that there can be any number of user computers used. Page 21, paragraph 279, discloses that any of the embodiments any of the computers can be used to transmit and receive information. From this the Examiner asserts that Joao does show at least two different entities exchanging information, and therefore Joao reads over the claim as currently written.

32. In response to the applicant's argument that, the prior art does not disclose "sending the electronic folder to an assessment center (i.e., not sending the part itself),"

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the Examiner respectfully disagrees. As discussed above Page 22, paragraph 299 of Joao discloses that at any time any over the different computers from various entities can access the information and input information regarding the vehicle. Page 10, paragraph 154, states that there can be any number of user computers used. Page 21, paragraph 279, discloses that any of the embodiments any of the computers can be used to transmit and receive information. From this the Examiner asserts that Joao does show at least two different entities exchanging information and modifying information, and therefore Joao reads over the claim as currently written.

33. In response to the applicant's argument that, the prior art does not disclose "amending/modifying the sent electronic folder at the assessment center to include an assessment comprising a grade (Joao does not disclose adding a grade)," the Examiner respectfully disagrees. As best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." Since the assessment and grade are equivalent Joao indeed does disclose amending/modifying the electronic folder with an assessment or grade.

34. In response to the applicant's argument that, the prior art does not disclose "disposing of the vehicular part based on the grade (neither Joao nor Hormozi disclose this step)," the Examiner respectfully disagrees. As discussed above the grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading..." Since the assessment and grade are equivalent the

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combination of Joao and Hormozi does in fact disclose disposing a part based on assessment or grade.

35. All rejections made towards the dependent claims are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and unpatentable over Joao and Hormozi where applicable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PRF

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
3/1/09